

1 structural cooperative relationships of elements, specifically the first, second, and
2 third sides. Applicants respectfully point out that the structural relationship of the
3 first, second, and third sides is recited in the claims 68 and 69, that they are all
4 sides of the packaging material. To point this out more clearly, Applicants have
5 amended claim 69 to include the structural cooperative relationship of --the
6 packaging material having a third side--. No new matter has been added.

7 The Examiner has commented with regard to claim 70 that it is unclear how
8 the flexible insert can be located between the lead and the first side of the
9 packaging material. Applicants' Specification Figures 22 and 23 portrays one
10 illustrative embodiment, in which the lead 2042 is C-shaped, and the insert 2080 is
11 disposed within the curve of the "C". Applicants' Specification has been amended
12 to clearly point to Figure --22-- (rather than Figure "20," which was a typo) for the
13 portrayed embodiment. In an embodiment, the lead can be a shape other than C-
14 shaped, such as another curved shape; or even a substantially straight shape or
15 another shape, that angles in compression about at least one pivot portion such that
16 the lead compresses toward the first side about the pivot portion, and the insert,
17 residing between the lead and the first side, supplies a spring force against the lead
18 in response to the lead contacting the insert in compression.

19 The Examiner has commented that in claim 80 "the metallic material" lacks
20 antecedent basis, and that it appears that claim 80 should depend on claim 79
21 rather than claim 78 to provide proper antecedent basis. Applicants have amended
22 claim 80 to provide the proper antecedent basis. No new matter has been added.

23 **The 35 U.S.C. § 102(e) Rejection of Claims 68-70, 74-79, 84-85, and 87-88**
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1 The Subject Application Claims 68-70, 74-79, 84-85, and 87-88 are not
2 anticipated by US 6,002,589 under 35 U.S.C. § 102(e).

3 The Examiner has rejected independent claim 68, and depending claims 69-
4 70, 74-79, 84-85, and 87-88 as being anticipated by US 6,002,589 (Perino) filed
5 on July 21, 1997, under 35 U.S.C. § 102(e).

6 Applicants submit that the subject application is a continuation of U.S.
7 Patent Application No. 09/468,247 filed Dec. 20, 1999, now US 6,352,435, and
8 that US 6,352,435 is a division of application No. 08/887,567, filed on July 3,
9 1997, now US 6,007,357, which is a continuation of application No. 08/452,120,
10 filed on May 26, 1995.

11 For a reference to qualify as prior art under 35 U.S.C. § 102(e), the
12 reference must have a filing date “before the invention thereof of the applicant”
13 (35 U.S.C. § 102(e)(2)) . The subject application date of invention is established
14 by claim of priority no later than May 26, 1995, the filing date of the subject
15 application’s parent, described above as application No. 08/452,120. All the
16 claimed subject matter was disclosed in the parent application. The filing date of
17 the US 6,002,589 reference is July 21, 1997, later than the priority date of the
18 subject application. Because the reference does not have a filing date prior to the
19 priority date of the subject application, the reference does not qualify as prior art
20 under 35 U.S.C. § 102(e). Therefore, Applicants respectfully respond that the
21 rejection is unfounded, and should be withdrawn, and the claims 68-70, 74-79, 84-
22 85, and 87-88, for at least this reason are not anticipated by US 6,002,589.

23 Applicants do not respond to Examiner’s comments concerning how US
24 6,002,589 anticipates Applicants’ claims because Applicants believe that US
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1 6,002,589 is not a valid prior art reference, not because Applicants acquiesce to
2 the Examiner's comments, and no negative inferences flow therefrom.

3 Additionally, dependant claims 69-70, 74-79, 84-85, and 87-88 71 being
4 dependant upon and further limiting independent claim 68, should be allowable for
5 that reason as well as for the additional limitations they contain.

6 The Subject Application Claims 68 and 69 are not anticipated by US 5,889,656
7 under 35 U.S.C. § 102(e).

8 The Examiner has rejected independent claim 68, and depending claim 69,
9 as being anticipated by US 5,889,656 (Yin) filed on May 23, 1997, under 35
10 U.S.C. § 102(e).

11 As described above with reference to the 35 U.S.C. § 102(e) rejection of
12 claims 68-70, 74-79, 84-85, and 87-88; the subject application claims priority to
13 May 26, 1995.

14 For a reference to qualify as prior art under 35 U.S.C. § 102(e), the
15 reference must have a filing date "before the invention thereof of the applicant"
16 (35 U.S.C. § 102(e)(2)) . The subject application date of invention is established
17 by claim of priority no later than May 26, 1995. All the claimed subject matter
18 was disclosed in the parent application. The filing date of the US 5,889,656
19 reference is May 23, 1997, later than the priority date of the subject application.
20 Because the reference does not have a filing date prior to the priority date of the
21 subject application, the reference does not qualify as prior art under 35 U.S.C. §
22 102(e). Therefore, Applicants respectfully respond that the rejection is unfounded,
23 and should be withdrawn, and the claims 68 and 69 for at least this reason are not
24 anticipated by US 5,889,656.
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1 Applicants do not respond to Examiner's comments concerning how US
2 5,889,656 anticipates Applicants' claims because Applicants believe that US
3 5,889,656 is not a valid prior art reference, not because Applicants acquiesce to
4 the Examiner's comments, and no negative inferences flow therefrom.

5 Additionally, dependant claim 69 being dependant upon and further
6 limiting independent claim 68, should be allowable for that reason as well as for
7 the additional limitations it contains.

8 **The 35 U.S.C. § 103(a) Rejection of Claims 70-83**

9 The Subject Application Claims 71, and 80-83 are not obvious over US 6,002,589
10 under 35 U.S.C. § 103(a).

11 The Examiner has rejected depending claims 71 and 80-83 under 35 U.S.C.
12 § 103(a), as being unpatentable over US 6,002,589.

13 As described above with reference to the 35 U.S.C. § 102(e) rejection of
14 claims 68-70, 74-79, 84-85, and 87-88, the US 6,002,589 patent is not a valid prior
15 art reference under 35 U.S.C. § 102(e) because the US 6,002,589 filing date is
16 later than the subject application priority date.

17 A 35 U.S.C. § 103(a) rejection must rely on references that qualify as prior
18 art under one of the sections of 35 U.S.C. § 102. US 6,002,589 does not qualify as
19 a prior art reference under 35 U.S.C. § 102. Therefore, Applicants respectfully
20 respond that the subject application claims 71, and 80-83 are not non-obvious over
21 US 6,002,589 because for at least the reason that US 6,002,589 is not valid prior
22 art for the subject application under 35 U.S.C. § 103(a).

23 Applicants do not respond to Examiner's comments concerning how the
24 Applicants' claims are unpatentable under 35 U.S.C. § 103(a) over US 6,002,589
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1 because Applicants believe that US 6,002,589 is not valid prior art, not because
2 Applicants acquiesce to the Examiner's comments, and no negative inferences
3 flow therefrom.

4 The Subject Application Claims 70-83 are not obvious over US 5,889,656 in view
5 of US 4,293,175) under 35 U.S.C. § 103(a).

6 The Examiner has rejected depending claims 70-83 under 35 U.S.C. §
7 103(a), as being unpatentable over US 5,889,656 in view of US 4,293,175
8 (Cutchaw).

9 As described above with reference to the rejection of claims 68 and 69
10 under 35 U.S.C. § 102(e) as being anticipated by US 5,889,656; US 5,889,656
11 does not qualify as prior art under 35 U.S.C. §102(e) because the US 5,889,656
12 filing date is later than the subject application priority date.

13 Because a 35 U.S.C. §103(a) rejection must rely on references that qualify
14 as prior art under one of the sections of 35 U.S.C. §102, US 5,889,656 is not valid
15 prior art under 35 U.S.C. §103(a). Therefore, Applicants respectfully respond that
16 the rejection of claims 70-83 is unfounded, and should be withdrawn. The subject
17 application claims 70-83 are not non-obvious over US 5,889,656 in view of US
18 4,293,175 for at least the reason that US 5,889,656 does not qualify as a prior art
19 reference for the subject application under 35 U.S.C. §103(a).

20 Applicants do not respond to Examiner's comments concerning how the
21 Applicants' claims are unpatentable under 35 U.S.C. § 103(a) over US 5,889,656
22 in view of US 4,293,175 because Applicants believe that US 5,889,656 is not valid
23 prior art, not because Applicants acquiesce to the Examiner's comments, and no
24 negative inferences flow therefrom
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CONCLUSION

Applicants respectfully request reconsideration of the rejection of these claims in view of the above remarks. Applicants respectfully submit that claims 68-83, and 85-88 are not anticipated and not obvious over the cited references. Thus, the claims are in condition for allowance. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,
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ATTACHMENT

The Claims

In accordance with CFR § 1.121, a marked-up version of amended claims 68, 69, and 80 showing all changes relative to the previous version of those claims is given below:

68. A chip package comprising:
packaging material having a first side and a second side,
a lead extending from the first side of the packaging material, and
a first clip portion extending from the[a] second side of the packaging material.

69. The chip package of claim 68, further comprising a second clip portion extending from a third side of the packaging material.

80. The chip package of claim 79[8], wherein the metallic material comprises beryllium-copper.

The Specification

In accordance with CFR § 1.121, a marked-up version of the replacing SPECIFICATION paragraph showing all changes relative to the previous version of the paragraph is given below:

--For another embodiment, an edge-mountable chip 2040 may have a C-shaped leads 2042 that wrap around a cylinder 2080 extending along the bottom of chip 2040 from left to right as illustrated in Figure 22[0]. Leads 2042 extend into a pocket or indentation formed by an extended portion 2041 of chip 2040. The pocket formed by extended portion 2041 helps to protect leads 2042

1 from being snagged, broken, or bent as a result of any mishaps in
2 handling chip 2040.--
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